

Attorney Docket No.: P051

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.: 09/954,717

ART UNIT: 1734

APPLICANT(S): Kenneth Noddings et al.

EXAMINER: Michelle A. Lazor

FILING DATE: September 17, 2001

TITLE: Fabrication of Optical Devices and Assemblies

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## RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patent  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicants elect with traverse Invention I, claims 1-13 and 26. With respect to the species election, applicants elect claims 1, 2, 4-13 and 26 of Invention I. Applicants traverse-in-part the restriction requirement for the following reasons.

The Examiner states that inventions I and II are unrelated. Invention II (claim 17) is drawn to a method of forming an optical waveguide assembly and Invention I (claim 1) is drawn to a method of forming an assembly of optical components that includes a waveguide. Thus, applicants submit that the inventions are not unrelated. Although claims 1 and 17 do not include identical steps, applicant submits that claims do not have to include identical steps to be related. If identical steps were required, dependent claims would be unrelated to their parents.

Regarding Inventions I/II and IV, claim 14 is a product-by-process claim dependent on claim 1. The Examiner states that claim 14 can be made a different process, such as injection molding. Claim 1 recites positioning components in a mold and applying a formable material into the mold to form a waveguide between the first and second components. The method of claim 1 does not exclude the use of injection molding in applying the formable material. This, injection molding is not another and materially different process.

## CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on May 17, 2004.

By: 

Name: Margarita Márquez-Escalona

Application No. 09/954,717  
Applicant(s): Kenneth Noddings et al.  
Response Dated May 17, 2004  
Response to Restriction Requirement of April 15, 2004  
Attorney Docket No.: P051

Two requirements are necessary for a proper restriction requirement: (1) the inventions must be independent or distinct; and (2) there must be a serious burden on the Examiner. MPEP 803. Applicants submit that the inventions and species, even if they were technically independent or distinct, are closely related, and the burden placed on the Examiner does not justify an eight-way restriction.

Respectfully submitted,

5/17/04  
Date

By: 

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May 17, 2004

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**Comments:**

Please see attached.

Michael O. Scheinberg  
Pat. Reg. No. 36,919

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